



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,853	03/07/2000	Michael O'Doherty	584-1022	8975

7590 03/05/2003

William M Lee Jr
BARNES & THORNBURG
P O Box 2786
Chicago, IL 60690-2786

EXAMINER

JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,853

Applicant(s)

O DOHERTY, MICHAEL

Examiner

Marlon Johnson

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 and 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-19 and 27-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Specifications

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "41" has been used to designate both SIP client E and host system (see page 10, lines 14-16). It appears that host system 41 should be host system 42, in a similar manner as host system 39 that corresponds to SIP client D 33 (see page 10, lines 13-15). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections – 35 U.S.C. 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 8,

The term "said mobile automated software agents" (page 27, lines 14-15) is lacking antecedent basis, as claim 1, which 8 is dependent upon, never describes any type of mobile automated software agents. It appears that claim 8 should be dependent upon claim 7.

In considering claim 15,

The term "the processor" (page 28, line 15) is lacking antecedent basis, as claim 1, which 15 is dependent upon, never describes any type of processor associate with the second SIP client. It appears "the processor" should be --a processor--.

Claim Rejections – 35 U.S.C. 103

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

In considering claims 24 and 25,

The limitation "A computer program arranged to control..." (page 29, line 15) is directed to the mere functionality of a computer program, and not to a computer-implemented process or apparatus that is executed to perform the functionality of the computer program.

It is suggested that the claims be amended to recite means within a computer-implemented apparatus such that the software program when executed by a computer enables the computer to perform the desired functions.

Claim Rejections – 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2153

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 5, 9, 10-15, and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al.(6,446,070), and further in view of Handley et al. (RFC 2543 – SIP: Session Initiation Protocol).

In considering claim 1,

Arnold et al. discloses a method of communicating between a first and a second node in a communications network, comprising the steps of:

(i) associating computer software with a message (see Fig. 3, Remote Compute Call 306; col. 6, lines 4-31);

(ii) sending the message from the first client associated with the first node to the second client associated with the second node (server) (see col. 6, lines 4-31; Fig. 3, Client 302, Server 316); and

(iii) executing the computer software using the second node (see col. 6, lines 23-41).

Although Arnold et al. shows substantial features of the claimed invention, he fails to specifically disclose a method wherein each of the nodes comprises an SIP client, as well as the message comprising an SIP message. However, Handley et al., whose invention is the Internet standard for SIP, Session Initiation Protocol, discloses such nodes comprising an SIP client (see page 9, lines 17-19; page 11, lines 4-7), as well as an SIP message being sent from the client to the server, with the message associated with an option message body (see page 25, lines 21-33). Therefore, given the teachings of Handley et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. by employing SIP clients and servers, as well as

associating SIP messages with computer software in order to utilizing the software in conjunction with the multimedia session conducted between the client and the server.

In considering claims 20 and 26,

Arnold et al. discloses a communications network node, as well as a communications network comprising a plurality of communications network nodes (see Fig. 1, Network 100), with each node comprising:

a client;

an input arranged to receive SIP messages which may be associated with computer software (see col. 6, lines 4-31); and

a processor arranged such that in use, when a message is received, any computer software code associated with that message is executed by the processor (see Fig. 2, CPU 205).

Additionally,

Handley et al. discloses an SIP client (see page 9, lines 17-19; page 11, lines 4-7), and an input arranged to receive SIP messages which may be associated with computer software code (see page 25, lines 21-33) (note the optional message body may, or may not, be associated with computer software code).

In considering claims 24 and 25,

Arnold et al. discloses a computer program (type or class), stored on a computer readable medium (remote hardware via URL), arrange to control a communications network node, the node comprising a client and a processor, the computer program being arranged to control the

node such that if a message is received by the client, any computer software code associated with the received message is executed by the processor (see Fig. 2, CPU 205; col. 8, lines 1-31).

Additionally,

Handley et al. discloses an SIP client (see page 9, lines 17-19; page 11, lines 4-7), and an input arranged to receive SIP messages received by the SIP server (see page 25, lines 21-33).

In considering claims 2 and 10,

Arnold et al. discloses a method wherein the computer software code is added to the message (see col. 6, lines 4-31)

Furthermore,

Handley et al. discloses a method wherein an optional message body is added to the body of the SIP message (see page 26, lines 14-19).

In considering claim 5,

Arnold et al. discloses a method wherein the computer software code comprises Java byte code (see col. 3, lines 47-51).

In considering claims 9 and 21,

Arnold et al. discloses a method wherein the second node comprises a Java virtual machine (see col. 3, lines 47-51).

In considering claims 11 and 23,

Handley et al. discloses a method which further comprises adding an indicator to the header of the SDIP message in order to indicate the presence of the computer software code and arranging the second SIP client to recognize the indicator (content-type) (see page 85, lines 4-9).

In considering claim 12,

Art Unit: 2153

Handley et al. discloses a method which further comprises the step of proceeding with any SIP process related to the SIP message (via general header) (see page 25, lines 22-40; page 26, lines 1-11; page 27, Table 3).

In considering claim 13,

Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to specifically disclose a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the message body associated with the SIP message is executed by the second node before that second node carries out any other process related to the SIP message. Nonetheless, this execution of the message body, or computer software (as previously combined to be located within the message body) would have been an obvious modification to the SIP message containing an indicator for the message body/computer software in its header. It would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by employing a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the message body associated with the SIP message is executed by the second node before that second node carries out any other process related to the SIP message in order to provide a level of priority for the message body/computer software over other SIP-specified processes, thus providing for the quick receipt of urgent computer software.

8. Claims 14, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Gampper et al. (6,003,082).

In considering claims 14, 15, and 22,

Art Unit: 2153

Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the computer software being arranged to interact with the second SIP client via a specified API. However, Byttner et al. et al., whose invention is a proposal for a Java extension API for SIP servers, discloses such a specified API (see page 3, lines 15-20, lines 35-46). Therefore, given the teachings of Byttner et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by arranging computer software to interact with the second SIP client via a specified API in order to the services needed to transport data across a network.

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Gampper et al.(6,003,082).

In considering claims 3 and 4,

Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the step of associating computer software code with the SIP message comprises adding a URL to the SIP message which indicates where the computer software is stored. However, Gampper et al., whose invention is the use of a server to selectively filter and cache internet access requests from the terminals attached to the server, discloses such a URL, added to a message, that indicates where computer software code is stored (see col. 2, lines 32-43). Therefore, given the teachings of Gampper et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by adding a URL to the SIP message which indicates where the computer software is stored in order to reduce the byte overhead of the message body containing the computer software code.

Art Unit: 2153

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Lowery (6,446,111).

In considering claim 5,

Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the computer software code comprises one or more Java applets. However, Lowery, whose invention is a data processing system that comprises a client device coupled to a communications link and operable to communicate a request over the communications link, discloses such a computer software code comprising one or more Java applets (see col. 6, lines 7-15). Therefore, given the teachings of Lowery, it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by providing computer software code that comprises one or more Java applets in order to provide compatibility with various Java-related classes, such as Java Database Connectivity (JDBC) classes.

11. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Lavian et al. (6,175,868).

In considering claim 5,

Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the computer software code comprises one or more Java mobile agents. However, Lavian et al., whose invention is a method and apparatus for automatically configuring a network switch having external network data ports, a processor, and memory, discloses such a computer software code comprising one or more Java mobile agents (see col. 6, lines 31-41). Therefore, given the teachings of Lavian et al., it would have been

Art Unit: 2153

obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by providing computer software code that comprises one or more Java mobile agents in order to provide compatibility with various Java-based environments, including mobile/wireless environments.

Election/Restriction

12. This application contains claims directed to the following patentably distinct species of the claimed invention:

- I: A method of communicating between a first and a second node in a communications network; Figs. 1-5; claims 1-15 and 20-26;
- II: A method of setting up a conference call between two or more parties; Figs. 6-7; claims 16 and 27-30;
- III: A method of upgrading or replacing interconnected SIP clients; Fig. 8; claims 17 and 31;
- IV: A method of testing members of a group of SIP clients; Fig. 9; claims 18 and 32;
- V: A method of forwarding a call from a first SIP client to a second SIP client; Fig. 10; claims 19 and 33.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, group I is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Art Unit: 2153

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. During a telephone conversation with William M. Lee on 2/20/03 a provisional election was made with traverse to prosecute the invention of group I, claims 1-15 and 20-26.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-19 and 27-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 2153

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (Yoakum et al. 6421674, Jalili et al. 5423042, Donovan 6434143, Bernstein et al. 6125366, Arnold et al. 6393497, Wollrath et al. 6487607).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marlon B. Johnson


KRISNA LIM
PRIMARY EXAMINER